

REMARKS

The Official Action of March 2, 2007 was a rejection based upon both under 35 U.S.C. §102(b) "...or, in the alternative, under 35 U.S.C. §103(a) as obvious over Koscitzky".

1. The Advisory Action of June 1, 2007 does not withdraw the rejection under Section 102, but considers it an "option". Thus, the inappropriateness of a rejection under Section 102 will now be addressed.

Koscitzky does not anywhere, in the drawings or text, teach completely removing the intermediate areas between tabs, which intermediate areas contain blends of shingle granules from each tab. It is axiomatic, and well established in patent law, that a Section 102 rejection cannot stand, if there is any feature of a claim that is not specifically taught in the applied reference.

Thus, no Section 102 rejection can stand.

In this regard, it was noted in the response previously filed on May 22, 2007 that the Examiner had misinterpreted Koscitzky in stating that the slots 76 "are located in all of substantially all of the transition areas 36 between adjacent colored areas, in that the Examiner interpreted the term "all" from column 5 line 5 of Koscitzky as meaning the entire width of the intermediate color transition region.

It was further pointed out that Koscitzky states that "the slots 76 are located in all or substantially all of the transition **areas** 36 between adjacent colored areas", and that Koscitzky did not state that the slots occupy all of any given transition area; merely that the slots appear **in each of the areas** 36 (emphasis added). It was further pointed out that the Examiner's reading of Koscitzky to the effect that the entirety of **any given** transition area is removed in Koscitzky is a mis-reading that is contrary to the teachings of Koscitzky.

Notwithstanding that earlier argument, in the Advisory Action of June 1, 2007 the Examiner maintained Section 102 as an "option".

There can be no valid Section 102 rejection over Koscitzky.

2. There is no valid Section 103 rejection over Koscitzky.

A. Koscitzky teaches away from complete removal of the intermediate areas. Koscitzky specifically wants the opposite of complete removal of the intermediate areas; namely to retain blended parts of the intermediate areas on each side of the shingle.

The prior arguments in this regard, in the earlier response to the final rejection are herewith repeated.

Koscitzky goes on to state (Column 5, lines 17-18) "...remove **the part** of the transition area where the two blends are approximately equal." (emphasis added).

Again, in Column 5, lines 26-29 Koscitzky states that "...it will remove **portions** of the transition area 36 where the granules from each blend 26a", 26b" have approximately a 50:50 ratio (as indicated by point 80 in Fig. 4). (emphasis added).

Again, Koscitzky goes on to say in Column 5 lines 29+ that "...the **portion** 36a of the transition area to the left of the left hand slot 76 in Fig. 7 will be predominantly" determined by the color of blend 26a", while **the portion** 36b of the transition area to the right of the left hand slot 76 will be largely determined by the color of blend 26b". (emphasis added).

Koscitzky continues to go on to say:

The portions 36a, 36b of the transition area which remain after the slot has been cut will not be noticed by the eye, because of the presence of the slot 76.

Again, Koscitzky is clearly stating that there will be portions of the transition area that are **not** removed.

Thus, over and over and over again Koscitzky emphasizes that it is only a portion of each transition area that is removed.

Clearly, all of the transition **areas** refers to the number of areas, not the entire width of any given area. Thus, the Examiner's interpretation is in error, and is completely contrary to Koscitzky's teaching and purpose.

Moreover, if one wishes to fully understand the goal of Koscitzky, one should look to claim 1, which is the broadest claim for which protection has been sought in Koscitzky.

Claim 1, in column 8 line 11-16 states:

...each transition area also containing an intermediate portion between said border areas where granules from both said neighboring patches are

present in substantial concentrations, said shingle having narrow slots between substantially all patches of granules...

And lines 19-23 go on to state:

said slots extending **within** said intermediate portions of said transition areas but said transition areas **being of greater width than said slots so that there is a portion of a transition area on each side of each slot...**(emphasis added).

The rejection of claims 8 through 10 as being unpatentable over Koscitzky in view of the admitted prior art, under Section 103(a) is respectfully traversed as being outside the teaching of Koscitzky, for all of the reasons set forth above.

Thus, Koscitzky itself provides a sound basis for the fact that it would **not** be obvious to modify Koscitzky to arrive at Applicant's invention here.

B. Complete removal of the intermediate areas is taught in Applicant's own disclosure which may not be relied upon, but apparently is being relied upon for a teaching of modifying Koscitzky, because, on this record, it is Applicant's application that teaches this feature.

3. The Examiner's citation of *In re Seid* 73 U.S.P.Q. 431, is misplaced.

A. *In re Seid* is a 1947 case. When one seeks to Shepardize this case, one finds no citation to it in all of the patent jurisprudence since 1947. In fact, while it is mentioned in MPEP §2144.04, mention of it is immediately followed by referring the reader to *In re Dembiczak* 175 F.3d 1994, 50 USPQ 2d 1616 (Fed. Cir. 1999). *In re Dembiczak* was a case in which an ordinary round trash bag was patented, based upon a reversal of the rejection, and involved an orange plastic trash bag with a jack-o-lantern face. Thus, as the MPEP recognizes, any reliance upon *In re Seid* has to be interpreted by what has happened in the 52 + years since *In re Seid* was decided. Clearly, the Federal Circuit does not currently apply any such teaching of *In re Seid* that the Examiner would seek to apply here. Moreover, as will be pointed out below, the practice of the Patent Office regarding ornamentation and aesthetic features in the 60 years since *In re Seid*, does not follow *In re Seid*; rather, patents in the shingle art and other fields are regularly granted based upon ornamental and aesthetic features.

B. The claims of the instant application however **do** require structural features that perform functions. See for example paragraphs 4(a)-(e) and 5(a)-(d) of the Snyder Declaration provided herewith. It will thus been seen that the features of the claims being sought in the instant application, regarding the slots, do have numerous functional features. As paragraph 4 of the Snyder Declaration points out, there are at least five such functional features regarding the slots, and with respect to paragraph 5 of the Snyder Declaration, there are at least four functional aspects to the structural features recited in the claims.

Thus, even if *In re Seid* remained viable law (which it does not), the claims of the instant application here meet any test once employed by *In re Seid*.

C. In the shingle art, many many utility patents are issued, and have been over the 60 years since *In re Seid* was decided, which are specifically directed to ornamental or aesthetic features, and therefore such ornamental aesthetic features satisfy requirement of function. See paragraph 12 of the Snyder Declaration provided herewith, specifically lines 1-6 thereof.

D. The roofing (including shingle) art is prolific with examples of shingles that have been patented as modifications of other prior art for decorative or aesthetic purposes, and such developments **do** distinguish over the prior art and are **not** considered obvious modifications, merely because they are aimed at decorative or aesthetic features. See the 51 patents listed in paragraph 12 of the Snyder Declaration provided herewith. See also paragraphs 6-10 of the Snyder Declaration, which specifically address over Mr. Snyder's 34 years in the shingle industry, how developments in shingles have been aimed at appearances designed into manufactured shingles, so as to emulate or simulate slate shingles, shake shingles, and tile shingles, and that such features are not regarded as being obvious ornamentation. Clearly, the evidence supported by the 51 patents listed in paragraph 12 is fully supportive of this proposition testified to by Mr. Snyder in the Snyder Declaration. Also, it should be noted specifically with reference to numbered paragraphs 9 and 10 of the Snyder Declaration that the shingle industry has invested heavily in the making of manufactured shingles that simulate such natural shingle materials.

E. At the bottom of page 3 of the Official Action of March 2, 2007, and again in the Advisory Action of June 1, 2007 (last 4 lines of paragraph 11 thereof), the Examiner has stated:

Modifying the teachings of Kosciatzky for strictly decorative or aesthetic purposes does not patentably distinguish over the prior art but rather would have simply been an obvious modification.

In view of all of the above, that statement is not correct and is not the law.

The practice of the USPTO, for more than the last 30 years has established that a great amount of the non-obvious inventions in the shingle art is specifically aimed at simulating shingles made of natural slate, tiles, cedar shakes or the like, and is thus ornamental or aesthetic. See also paragraph 12 of the Snyder Declaration, last subparagraph thereof.

F. Kosciatzky itself, the very reference applied in this case, is **itself** aimed at aesthetics. The Examiner is thus applying a different standard to the instant application than that which was applied to Kosciatzky and different than that applied in the 51 other issued patents referenced in paragraph 12 of the Snyder Declaration.

4. As was addressed in part above, the Examiner's interpretation of "all" to mean the entire width of the slot, as addressed in page 5 line 4 of the Official Action of March 2, 2007, is not a correct reading of Kosciatzky. Perhaps the visual differences can better be made clear with reference to Exhibits B and C of the Snyder Declaration that are addressed in numbered paragraphs 13 and 14 of the Snyder Declaration. Note the contrast to the text and illustrations of Kosciatzky relative to what is shown in Exhibits B and C, where the complete removal of the transition areas in Exhibits B and C, as are further addressed in the drawings and text of the instant application, relative to the teaching of Kosciatzky of specifically retaining portions of the intermediate area on each side of the slot as taught in Kosciatzky. It is submitted that the visual contrast that is presented by Exhibits B and C and addressed in numbered paragraphs 13 and 14 of the Snyder Declaration support the differences of the present invention over Kosciatzky, and the unobviousness of the present invention over Kosciatzky.

5. The expert testimony is that the invention of this application is not obvious.

A. Richard Allan Snyder is an expert in the shingle art. See paragraphs 1-3 and 6-12 of the Snyder Declaration, as well as his curriculum vitae in Exhibit A to the Snyder Declaration.

B. The *Graham v. Deere* 383 U.S. 1, 148 USPQ 459 (1966) test for unobviousness is met in this case. Reference is made specifically to numbered paragraphs 15, 16, 17, 18 and 19 of the Snyder Declaration, wherein the *Graham v. Deere* test of scope and content of the prior art, a determination of the differences between the prior art and the claims under consideration, and a determination of the level of ordinary skill in the pertinent art are addressed. They all support the unobviousness of the present invention.

C. Commercial success under *Graham v. Deere* as a secondary indicia of unobviousness is established in this case, and supports the unobviousness of this invention. In this regard, reference is made to paragraph 20 of the Snyder Declaration which supports not just that shingles made in accordance with this invention have been a commercial success. Mr. Snyder goes on to state that such commercial success is "stunning". This is based upon his 34 years of experience in this art.

D. The expert opinion of unobviousness is supported by the record in this case, and the conclusion of unobviousness of paragraph 21 of the Snyder Declaration necessarily flows from not only the other paragraphs of the Snyder Declaration and Exhibits in this case, but also from the instant application itself, as compared with the teaching of Kositzky.

6. Conclusion

In view of all of the above, reconsideration and allowance of all of the claims of this application are respectfully requested.